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| 10/049,410 | 02/07/2002 | Udo Bickers | 514413-3911 | 1061 |
| 20999 7590 03/04/2010 FROMMER LAWRENCE & HAUG 745 FIFTH AVENUE- 10TH FL. NEW YORK, NY 10151 | | | | |
| EXAMINER | | | | |
| PRYOR, ALTON NATHANIEL | | | | |
| ART UNIT | | PAPER NUMBER | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/049,410

Applicant(s)

BICKERS ET AL.

Examiner

ALTON N. PRYOR

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-61 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/226)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Applicant's arguments filed 9/3/09 have been fully considered but they are not persuasive. Previous rejections not recited in this office action have been withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33,34,37-43,45-49,52,53,55-57,59 and 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levitt et al (USPN 4371391; 2/1/83). Levitt et al teach herbicidal compositions comprising a benzenesulfonamide herbicide plus polyacrylic acid thickener (column 46 Example 10) or silica aerogel (column 47 Example 14). Levitt et al suggest the addition of another herbicide such as paraquat (column 48 line 59- column 60 line 14) to the composition. Levitt et al teach a method of applying the composition to plants for the control of unwanted vegetation. Levitt et al do not exemplify an invention comprising a benzenesulfonamide plus polyacrylic acid thickener or silica gel plus paraquat. However, it would have been obvious to make such an invention. One would have been motivated to do this since Levitt et al suggest the combination of said ingredients.

Response to Applicants' Argument

Applicants argue that there is no evidence to support that a pre-emergent herbicide would not be used in a pre-emergent manner. The Applicants further argue that the Examiner provides no evidence to support that a post-emergent herbicide would be used in a pre-emergent manner. The state of the art teaches against the use of a post-emergent herbicide in a pre-emergent manner. The Applicants cite literature by Hoerlein, Torstensson, Sprankle et al., Rueppel et al., to support that post-emergent herbicides are used post-emergently and pre-emergent herbicides are used pre-emergently. The Examiner argues that the evidence is in the teaching of Levitt. Note, Levitt, at column 3 line 65 - column 4 line 2, column 48 lines 30-45 and Examples 10 and 14, indicates or suggests that the composition containing the active and acrylic polymer may also contain paraquat. Levitt, at column 48 line 59 – column 49 line 19, teach that the compositions disclosed may be applied pre-emergently. The evidence comes from the teaching in Levitt. From the citing above Levitt's prior art suggest the use paraquat, a post-emergent herbicide, in a pre-emergent manner. Note, instant claims apply paraquat (post-emergent herbicide) and acrylic polymer pre-emergently.

Applicants provide data in specification and in Dr. Bickers' declaration to support that the post-emergent herbicides applied pre-emergently are effective. The Examiner argues that the Examples are unclear since the chemical components contained therein are undefined. The ingredients: Luquasorb AF1, Sipernat 22S, Duasyn acid blue AE, Basta 150, Aerogel P88, Geroon SDS, Kobate C, Mergal K9N, Silcolapse are not defined in the specification.

Claims 48-52,54,56-58,60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bieringer et al (USPN 6159900; 12/12/00) and Frisch et al (USPN 4853026; 8/1/89). Bieringer et al teach herbicidal compositions comprising a herbicide such as paraquat plus an alkyl polyglycol ether sulfate plus optional actives such as fertilizers and/or insecticides (abstract, claim 1). Bieringer et al teach a method of applying the composition to plants for the control of unwanted vegetation (claim 9). Bieringer et al do not exemplify an invention comprising paraquat plus alkyl polyglycol ether sulfate plus optional fertilizers and/or insecticides. However, it would have been obvious to make such an invention. One would have been motivated to do this since Bieringer et al suggest the combination of said ingredients. Bieringer et al also does not teach an invention comprising glufosinate. However, Frisch et al teach a herbicidal compositions comprising glufosinate plus an alkylphenol polyglycol ether (abstract, claim 1). It would have been obvious to modify the invention taught by Bieringer et al to include the glufosinate taught by Frisch et al. One would have been motivated to do this since both inventions individually are to herbicides.

Response to Applicants' Argument

The Examiner maintains that it is obvious to combine Bieringer et al. and Frisch et al. since both references have the same utility, i.e., both references disclose herbicidal utility. Claims rejected over Levitt are drawn to the composition of the invention.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 33-36,38,40,45-51,54,56-58,61 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,2,8,21 and 25 of U.S. Patent No. 6770594. Although the conflicting claims are not identical, they are not patentably distinct from each other because USPN makes claim to a composition comprising agrochemical active substance. In the specification at column 7 lines 5-24 it is recited that the active can be glufosinate and/or glyphosate. In the specification at column 10 line 63- column 11 line 16 it is recited that the active can be bialaphos. Glufosinate, glyphosate and bialaphos are post-emergent herbicides. USPN at column 16 lines 24-59 discloses that the herbicide can be placed onto adsorptive materials such as clays and polyacrylates. USPN claims that post-emergent herbicides can be applied pre-emergently. Although USPN claims make instant invention obvious the USPN claims are of different scope than instant claims. For

example, USPN requires a silicone surfactant, whereas instant claims do not require the silicone surfactant.

Response to Applicants' Argument

Applicants argue that in making a double patenting rejection the Examiner must rely on a comparison of the instant claims and the patented claims or claims pending in an application. The Examiner argues that the patent's specification is employed in this rejection to define terms, such as surfactants and additives, present in the patented claims. The definition of terms make it clear that the patented claims read on the instant claims. Applicants argue that USPN '594 refers to herbicidal active substances in combination with a surfactant other than a silicone surfactant and one or more hemectants. The Examiner argues that USPN '594 makes claim to a composition comprising a herbicide plus a surfactant in claim 1. In column 7 lines 5-24 USPN '594 teaches that the herbicide can be of the glufosinate type and in column 13 lines 45-55 USPN '594 teaches that the surfactant can be an alkyl polyglycol ether sulfate. The combination of glufosinate plus alkyl polyglycol ether sulfate makes the instant claims obvious.

Claims 33-36,38,40,45-51,54,56-58,60 and 61 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,3 and 4 of U.S. Patent No. 6693063. Although the conflicting claims are not identical, they are not patentably distinct from each other because USPN makes claim to a composition comprising agrochemical active substance. In the specification at column 18 lines 51-67 it is recited that the active can be glufosinate and/or glyphosate. In the

specification at column 25 lines 14-44 it is recited that the active can be bialaphos. Glufosinate, glyphosate and bialaphos are post-emergent herbicides. USPN at column 25 lines 39-41 discloses that the herbicide can be placed onto adsorptive materials such as clays and polyacrylates. USPN claims that post-emergent herbicides can be applied pre-emergently. Although USPN claims make instant invention obvious the USPN claims are of different scope than instant claims. For example, USPN requires at least a 12 alkylene oxide unit containing surfactant, whereas instant claims do not require the said surfactant.

Response to Applicants' Argument

Applicants argue that in making a double patenting rejection the Examiner must rely on a comparison of the instant claims and the patented claims or claims pending in an application. The Examiner argues that the patent's specification is employed in this rejection to define terms, such as surfactants and additives, present in the patented claims. The definition of terms make it clear that the patented claims read on the instant claims. USPN teach that the surfactant can be a polyglycol (column 10 line 63- column 11 line 10, column 16 lines 29-36, Example 2). Applicants argue that USPN '063 refers to 1,3-halo-2-alkoxy-5-cyano-phenyl compounds as herbicidal active substances in combination with a surfactant comprising 12 alkylene oxide units as structural element. The Examiner argues that USPN '063 makes claim to a composition comprising 1,3-halo-2-alkoxy-5-cyano-phenyl compounds and a surfactant in claim 1 and additionally comprising a further component selected from an agrochemically active compound in claim 3. In column 18 lines 55-67 USPN '063 teaches that the further agrochemically

active compound is glufosinate and in column 10 lines 40-62 USPN '063 teaches that the surfactant can be an fatty alcohol polyglycol ether sulfate. The combination of glufosinate plus fatty alcohol polyglycol ether sulfate makes the instant claims obvious.

Other Matters

Per Attorney's request, the Examiner phone Attorney Lee to discuss application. Attorney informed the Examiner that he would return the call to discuss application on Friday, February 26, 2010. The Examiner did not receive a return call from the Attorney. The Examiner is willing to discuss the application with the Attorney at a later date.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Telephonic Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alton N. Pryor whose telephone number is 571-272-0621. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alton N. Pryor/
Primary Examiner, Art Unit 1616